

## **RESPONSE**

This is a response to an Office Action mailed August 3, 1998. Claims 1-30 are pending in this application. Claims 1, 9, 17, 22, and 25 are the independent claims. In response to the previous Office Action mailed April 30, 1998, which had rejected claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Patent No. 5,668,863 to Bieselin et al. ("Bieselin"), Applicant amended claims 1, 9, 17, and 22 in order to clarify what Applicant regards as his invention and respectfully requested reconsideration of the above-identified application in view of the amendments and remarks presented.

In the August 3, 1998 Office Action, claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieselin in view of U.S. Pat. No. 5,740,304 to Katsuyama et al. ("Katsuyama"). Claims 25-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieselin. By this amendment, applicant has amended claim 9 in order to correct a typographical error and amended claim 25 in order to clarify what Applicant regards as his invention. The rejections are addressed below.

### **Claims 1-24 Patentably Define The Invention Over Bieselin in view of Katsuyama**

Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieselin in view of Katsuyama. This rejection is respectfully traversed because Bieselin in view of Katsuyama does not teach a system which bookmarks a user's progress in reviewing previously recorded material when the user terminates a first

review session. Moreover, Katsuyama does not teach correlating a bookmark with a specific user.

Independent claims 1, 9, 17, and 22 each define a system which "bookmarks" a specific user's progress in listening to a previously recorded audio program communicated to the user over a communication network when the user terminates a first review session. The system then provides the user with the option of restarting the program, for example, from that bookmark in a subsequent review session. The present invention would mark the user's progress when he or she terminates a first review session by disconnecting from the network. Then, on a subsequent session, the user would be able to continue from the point where he or she disconnected -- without having to start from the beginning of the material or knowing where in the program he or she left off.

As previously explained in Applicant's response to the Office Action mailed April 30, 1998, Bieselin does not teach the step of tracking the "progress in the user review of [the previously recorded material] during a first review session." Bieselin concerns marking significant points of material as it is being recorded. It does not allow a user to stop and bookmark a program as it is being played back. Moreover, the Bieselin bookmark is not indicative of the termination of a session.

Unlike the present invention, Katsuyama concerns marking various points of audio material that would allow any subsequent reviewer of that audio material easy access to previously bookmarked points. There is no teaching in Katsuyama that particular bookmarks can be set for particular users. Whereas Katsuyama's bookmarks are associated only with an audio program, the present invention's

bookmarks are associated with both a specified user and a specified audio program. Thus, under Katsuyama, any subsequent reviewer of the audio material would have access to, and/or be inconvenienced by, the bookmarks of the previous reviewer. Furthermore, like Bieselin, the Katsuyama bookmarks are not indicative of the termination of a review session.

In contrast to both Bieselin and Katsuyama, the bookmark in the present invention is associated with the termination of a review session by a user, and that user can start a new session from that bookmark at any time. There is no teaching in either Bieselin or Katsuyama that a bookmark be associated with a termination of a review session. Indeed, both Katsuyama and Bieselin teach away from the present invention in that they require a user to depress a specialized input key in order to set a bookmark. (See Bieselin at col. 7, lines 26-31; Katsuyama at col. 20, lines 52-59). Thus, the purpose and spirit of the bookmarks in Bieselin and Katsuyama are different than that of the present invention and, consequently, there is no suggestion to adapt their bookmarks to that claimed for the present invention. Therefore, Applicant respectfully submits that the present invention would not have been obvious, in view of Bieselin and/or Katsuyama, to one of ordinary skill in the art at the time the invention was made. Accordingly, Applicant respectfully submits that claims 1-24 are patentable over Bieselin in view of Katsuyama.

**Claims 25-30 Patentably Define The Invention Over Bieselin**

Claims 25-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bieselin. The Examiner's rejection of claim 25 is the same in the August 3,

1998 Office Action and the April 30, 1998 Office Action, notwithstanding Applicant's June 3, 1998 Remarks explaining that:

Independent claim 25 was not amended. This is because claim 25 explicitly describes a playback position monitor coupled to [a] program playback module..." [emphasis added] (claim 25, lines 6-7). Thus it directly reflects the differences between the present invention and Bieselin.

(June 3, 1998 Remarks at 4). The Examiner has not responded to that earlier remark.

Applicant respectfully submits that claim 25 is patentable over Bieselin.

Claims 26-30 depend from claim 25. As such, Applicant submits that they are allowable for at least the same reasons as those set forth above with regard to claim 25.

### CONCLUSION

In view of the remarks submitted above, the Applicant requests reconsideration and withdrawal of all grounds of rejection. A Notice of Allowance is earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or §1.17 to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (202) 429-1776 to discuss any matter concerning this application.

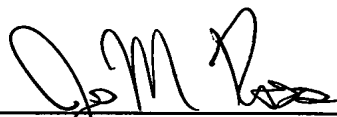
Respectfully submitted,

KENYON & KENYON

Date:

Dec. 15, 1998

by:



James M. Ross  
(Reg. No. 42,115)

KENYON & KENYON  
1025 Connecticut Avenue, N.W., Suite 600  
Washington, D.C. 20036  
Phone: (202) 429-1776  
Facsimile: (202) 429-0796

**RECEIVED**

DEC 22 1998

Group 2700